

REMARKS

By this Amendment, claims 1-148 and 179-199 have been canceled without prejudice or disclaimer and new claims 223-236 have been added. Applicants reserve the right to re-present the subject matter of canceled claims 1-148 and 179-199 at a later time in this application or in a related application. New claims 223-236 depend either directly or indirectly from one of independent claims 200 and 212. New claims 223-236 have been added to further define the invention and are fully supported by the original specification and drawings. No new matter has been added.

Restriction Requirement

Page 2 of the outstanding Office Action indicates that a restriction between two inventions, Group I, claims 1-74, 148, and 179-222, and Group II, claims 75-147, was required by the Examiner. The Office Action also states that an election of species between the following allegedly patentably distinct species was required: 1) Fig. 1A; 2) Figure 1C, 3) Figure 2A, 4) Figure 3A; 5) Figure 4A; 6) Figures 6A-6I; 7) Figures 7A-7I; 8) Figures 8A-8I; 9) Figures 9A-9H; and 10) Figure 10A.

Applicants note that the grouping of the claims into Groups I and II is significantly different from the grouping of the claims explained to Applicants' representative via the telephone. In addition, the listing of the allegedly patentably distinct species between which Applicants were required to choose is significantly different from the list of Species explained to Applicants' representative via the telephone. Over the telephone, the Examiner indicated that there were more than six (6) inventions, and that the group of claims that included claim 200 was claims 200-222. Thus, Applicants' representative elected claims 200-222. After electing claims 200-222, Applicants' representative was asked to choose between the following four (4) species: Figures 6A-6I; Figures 7A-7I;

Figures 8A-8I; and Figures 9A-9H. Applicants' representative elected the species of Figures 6A-6I and indicated that all of claims 200-222 "read" on that species.

Applicants do not necessarily agree with the various characterizations and assertions regarding either Applicants' claims or the allegedly patentably distinct groups and species that are set forth in the Office Action or that were set forth in the telephone conference with the Examiner. Nonetheless, in an effort to expedite prosecution of this application, Applicants will continue to prosecute originally elected claims 200-222, all of which "read" on elected Species 6, Figures 6A-6I. Applicants statement that all of claims 200-222 "read" on elected Species 6 is not an admission that these same claims also do not "read" on a number of additional species set forth in the Office Action nor is it an admission that a number of the non-elected method claims of Group I do not "read" on elected Species 6.

By this Amendment Applicants add new dependent claims 223-236. New dependent claims 223-236 also "read" on elected Species 6.

§ 103(a) Rejections

On pages 4-5 of the outstanding Office Action, claims 200-204, 207-216, and 219-222 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pierpont, U.S. Patent No. 5,484,412, in view of Parodi, U.S. Patent No. 6,206,868.

The Office Action states that Pierpont discloses all of the claimed limitations except subsequent to dilating the lesion, using active suction to induce retrograde flow. The Office Action further states that Parodi teaches using active suction to induce retrograde flow subsequent to dilating the lesion and that "[i]t would have been obvious to one with ordinary skill in the art to use the teachings of Parodi to modify the invention of

Pierpont and include the step of suctioning in order to induce retrograde flow in the vessel of interest.” Pages 4-5 of Office Action.

Applicants respectfully disagree. Pierpont does not disclose every limitation of independent claims 200 and 212, with the exception of retrograde flow, as stated in the Office Action. Each of independent claims 200 and 212 require, among other things, “prior to advancing the dilation balloon across the lesion to be treated, deploying the at least one sealing surface to occlude normal antegrade flow within the blood vessel” (emphasis added). Contrary to the Examiner’s assertions, Pierpont does not disclose occluding normal antegrade flow within the blood vessel. The structure of Pierpont includes a plurality of perfusion ports 40 that allow blood to flow through the anchoring catheter 22 and coronary artery. These perfusion ports 40 render Pierpont incapable of occluding normal antegrade flow.

Therefore, the combination of Pierpont and Parodi as suggested in the Office Action would not result in the invention as claimed. Normal antegrade flow must be stopped prior to inducing retrograde flow. Thus, to successfully use the retrograde flow taught by Parodi with the device of Pierpont, it would first be necessary to eliminate the perfusion ports of Pierpont. However, Pierpont teaches that the perfusion ports are a critical structural element necessary to prevent stoppage of oxygenated blood flow. Pierpont states that “[t]his is very critical so as to continue to support the heart muscle 10 with oxygen while the balloons are inflated and anchoring the guiding catheter to the coronary artery.” Col. 4, lines 44-49. Removing the perfusion ports of Pierpont would render the Pierpont invention unsatisfactory for its intended purpose and change the principle of operation of Pierpont. There is no suggestion or motivation to make a

proposed modification that would render a prior art invention unsatisfactory for its intended purpose. *In re Gordon*, 733 F.3d 900 (Fed. Cir. 1984). In addition, if a proposed combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references do not support a *prima facie* case of obviousness. *In re Ratti*, 270 F.2d 810 (CCPA 1959). For at least these reasons, independent claims 200 and 212 are patentable over Pierpont and Parodi, either alone or in combination. Dependent claims 201-211 and 213-236 are also patentable over Pierpont and Parodi for at least the same reasons as independent claims 200 and 212. Withdrawal of this rejection and reconsideration of the claims is requested.

Claims 205, 206, 217, and 218 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pierpont in view of Parodi, and further in view of Barbut, U.S. Patent No. 6,146,370. The Office Action relies on Barbut for teaching advancing a stent into a blood vessel. However, Barbut does not cure the deficiencies of Pierpont as discussed above. Claims 205 and 206 depend from independent claim 200 and claims 217 and 218 depend from independent claim 212, and therefore, for at least the same reasons discussed above with regard to independent claims 200 and 212, claims 205, 206, 217, and 218 are patentable over each of Pierpont, Parodi, and Barbut, either alone or in any combination. Withdrawal of this rejection and reconsideration of the claims is requested.

Claims 201-211 and 223-229 depend from independent claim 200, and are therefore allowable for at least the same reasons claim 200 is allowable. Claims 213-222 and 230-236 depend from independent claim 212, and are therefore allowable for at least the same reasons claim 212 is allowable. In addition, each of the dependent claims

recites unique combinations that are neither taught nor suggested by the cited art, and therefore each also are separately patentable.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

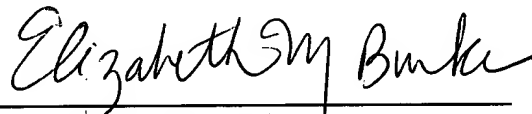
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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